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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,367	07/08/2003	Michael Black	MIB-102	2320

30869 7590 03/25/2005

LUMEN INTELLECTUAL PROPERTY SERVICES, INC.  
2345 YALE STREET, 2ND FLOOR  
PALO ALTO, CA 94306

EXAMINER
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JOHNSON III, HENRY M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/616,367	Applicant(s) BLACK, MICHAEL 	
	Examiner Henry M Johnson, III	Art Unit 3739	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4-23-04 and 1/31/05</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 2, 4, 9, 30, 32, 34 and 36-38 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Device and apparatus claims require further structural limitations.

Claim 6 is objected to as relating to a treated body unrelated to the structure of the device.

Claim 9 includes an agent, not an integral part of the device, proper in a system claim, but imparting no alteration to the device structure.

Claims 39 and 40 are objected to under 37 CFR 1.75 as being substantial duplicates of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The preamble structure is not limiting structure.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7, 12, 15-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 7 is rejected for inclusion of application of light, a method of use, in a device claim (MPEP § 2173.05(p) II).

Claim 12 is indefinite as it is unclear what is being fed back. No sensing is cited leaving the term feedback open ended.

Claims 15 and 24-28 are indefinite for having no enabling step to actually execute the method. The term providing adds to the structure, yet imparts no active step to apply hygienic effects.

Claim 16 is indefinite for adding no active step to the method.

Claim 29 is indefinite due to a typographical error deleting the number of light sources.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 10-22, 24-32 and 39-40 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,238,425 to Thiberg. Thiberg discloses an apparatus for external medical treatment (therapeutic) with the aid of light. A light-emitting device is provided that includes light-emitting diodes (LEDs). A drive arrangement is adapted to cause the light-emitting device to pulsate the light in accordance with a predetermined pulse frequency

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(abstract). The LEDs inherently have a lens cover and a beam with a set divergence that inherently define an optical path. The LEDs radiate through a transparent plate (Fig. 2, # 6), the plate meeting the applicant's definition of an optical component being a transparent material. The LEDs can provide visible or infrared radiation (Col. 2, lines 54-58) and may be of different wavelengths (Col. 4, lines 9-10) or different power levels (Col. 2, lines 59-61). The applicator (Fig. 2) is interpreted as providing massage ability as it is moved over a treatment site, the manual movement being mechanical. A display of operational data is provided (Fig. 1, #14) that provides feedback to the operator and a keyboard provides an input selection capability. The method of use is implicit from the structure in that the device must be applied over the acupuncture points.

Claims 1-13, 15-27, 29, 30, 32, 39 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication US 2004/0193235 to Altshuler et al. Altshuler et al. teach an apparatus for delivering light radiation for therapeutic treatment of bacteria (paragraph 0004), tongue diseases (paragraph 0007) and acne (paragraph 0016). The radiation source can include a plurality of light sources, for example, a matrix or an array of light emitting diodes (LED), generating radiation in similar or different bandwidths (paragraph 0066). The LEDs may be arranged in a brush, using the bristles as optical paths (paragraph 0090) for radiation delivery (Fig. 7). The wavelength may be infrared (paragraph 0071) or visible (paragraph 0086). Mechanical massage is provided by the operation of the device or a vibrating means may be included (paragraph 0100). Altshuler et al. disclose applying agents during use (paragraph 0017). The apparatus may include sensors that provide the user with a variety of other information, such as, sensing and alerting a user when a treatment session is complete, when the oral appliance is properly positioned, when the oral appliance is in contact with tissue, and/or if the temperature in the treatment area rises above a predetermined level. Sensors can

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also be used with a controller to provide auto-feedback control of a treatment session(s) (paragraph 0098). The alert inherently must be audio, visual or tactile. The controller associated with the feedback or the switch in the handle provide selection capability. The handle portion and the body portion are removably and irreplaceably (disposable) mated with one another to allow cleaning and/or replacement (paragraph 0065).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication US 2004/0193235 to Altshuler et al. Altshuler et al. are discussed above and teach the handle and head being detachable for replacement (disposal). At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to selectively choose the replaceable parts because Applicant has not disclosed that replacing individual parts as opposed to an integrated module provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a variety of removable parts because all allow for cleaning and/or replacement.

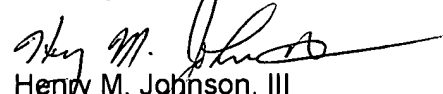
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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Henry M. Johnson, III  
Primary Examiner  
Art Unit 3739